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EXAMINER

ORTIZ CRIADO, JORGE L

ART UNIT	PAPER NUMBER
2655	

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/898,150

Applicant(s)

UHDE ET AL.

Examiner

Jorge L Ortiz-Criado

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 08/09/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Newly submitted claim 19 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The inventions are distinct, each from the other because of the following reasons:

Inventions I-claim 19 and II- (claims 1-18; 20-21) are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the subcombination II specifies identifying recording mediums among the same type and detecting identification item to identify the recording medium individually among recording media of the same type; and/or does not require the particulars of having an “unmodifiable identification data”. The subcombination has separate utility such as identify disc among the same type of discs individually.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 19 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Objections

2. Claims 5,6, 11 and 12 objected to because of the following informalities:

The term "BCA" should be "Burst Cutting Area (BCA)"

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 20-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The feature of "**unmodifiable identification data**" is not defined in the specification and no description of How, Where, When, What is this data described. The only description founded of identification data is burst cutting area, which is used to identification, but NO description is made about how this information is unmodifiable.

Claim 20-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in

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the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The feature of **“unmodifiable identification data”** is not defined in the specification and no description of How, Where, When, What is this data is described as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make the data unmodifiable. The only description founded of identification data is burst cutting area, which is used to identification, but NO description is found on how the identification information data is made unmodifiable.

What does exactly the Applicant means with the recited feature “unmodifiable identification data”?

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 recites the limitation "the identification information item" in line 6 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 7, recites the limitation “said identification **item**[[s]]”, in lines 7 and 10 of the claim. There is insufficient antecedent basis for this limitation in the claim

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A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

In the present instance, claim 1 and 7 recites the broad recitation "**items**", and the claim also recites "**item**" which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 7-9, 13-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Bakx U.S. Patent No. 5,072,435.

Regarding claim 1, Bakx discloses a method for quickly producing read or write readiness of an apparatus for reading from or writing to an optical recording medium, the recording medium having identification information items which individually identify the recording medium individually among recording media of the same type (See Abstract; col. 1, line 35 to col. 2, line 57), comprising the steps of:

a) detecting the identification information item from said optical recording medium to identify the recording medium individually among recording media of the same type checking in a storage means for a stored adjustment parameter value associated with said recording medium and c) reading said stored adjustment parameter value from said storage means, if the check made in said step b) is positive, and adjusting said apparatus in accordance with said adjustment parameter value read, to facilitate one of reading and writing to said recording medium (See col. 2, lines 1-21; col. 5, lines 31-49; Fig. 1, 2)

Regarding claim 2, Bakx discloses wherein if the check in said step b) is negative, said apparatus is adjusted in order to be able to read from or write to a data area of the optical recording medium, and afterwards, associated with the recording medium, and at least one adjustment parameter value corresponding to the adjusted state of the apparatus is stored in said storage means. (See col. 5, line 48-61; Fig. 2)

Regarding claim 3, Bakx discloses wherein said storage means comprises a “non-volatile” memory (see Fig. 1, ref# 12)

Regarding claim 7, apparatus claim 7 is drawn to the apparatus that performs the corresponding method claimed in claim 1. Therefore apparatus claims 7 correspond to method claim 1 and are rejected for the same reasons of anticipation as used above.

Regarding claim 8, Bakx discloses wherein said detection means are formed by the write means or read means (See Fig. 1, ref#3)

Regarding claim 9, wherein said control means are configured in such a way that, in the case where, for the identified individual recording medium, it has not been possible to identify an adjustment parameter value in the storage means, said control means carry out an adjustment of the write means or read means and, associated with the identified individual recording medium, store in the storage means at least one adjustment parameter value corresponding to the adjusted state of the write means or read means (See col. 5, line 48-61; Fig. 2)

Regarding claim 15 and 16, Bakx discloses wherein together with the at least one adjustment parameter value the identification information item is stored in said storage means (See col. 2, lines 1-21; col. 5, line 31-61; Fig. 2)

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Regarding claim 17 and 18, Bakx discloses wherein the step of checking comprises sub-steps of: ba) reading from the storage means a next stored adjustment parameter value and a read identification information item that was stored together with it; bb) checking whether the read identification information item is equal to the detected identification information item (See col. 2, lines 1-21; col. 5, line 31-61; Fig. 2)

Regarding claim 20, claim 20 recites limitations similar to the claim 1 above and is rejected for the same reasons of anticipation as used above. The feature “unmodifiable identification data”, which is not found described in the specification, has been treated as to be an “identification information items”.

Regarding claim 21, claim 21 recites limitations similar to the claim 7 above in more broadly manner and is rejected for the same reason of anticipation as used above. The feature “unmodifiable identification data”, which is not found described in the specification, has been treated as to be an “identification information items”.

Regarding claims 13 and 14, Bakx discloses wherein said apparatus is configured for reading from and/or writing optical recording mediums, hence is also capable to be “configured” to read/write DVD-ROM disc as optical recording mediums.

Claim Rejections - 35 USC § 103

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 4 and 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bakx U.S. Patent No. 5,072,435 in view of Scibora U.S. Patent No. 6,366,544

Regarding claim 4 and 10, wherein a non-volatile data carrier is provided externally to the apparatus, and in that the content of a file on said non-volatile data carrier is accepted into a memory in the apparatus and is accessed as the storage means in said steps b) and c).

Bakx discloses all the limitations based on claim 3 and 7, as outlined above. Bakx further discloses wherein said nonvolatile memory is provided into the apparatus and is accessed in said steps b) and c). But Bakx does not expressly disclose a non-volatile data carrier provided externally to the apparatus, and in that the content of the file of said non-volatile data carrier is accepted into a memory, which is provided in the apparatus.

However this feature is well known in the art as evidenced by Scibora, which discloses a non-volatile data carrier provided externally to an apparatus, and in that the content of the file of said non-volatile data carrier is accepted into a memory, which is provided in the apparatus (See col. 3, lines 9-11; col. 4, lines 21-29; Fig. 1).

Therefore it would have been obvious to one with ordinary skill in the art at the time of the invention to include an non-volatile data carrier provided externally to the apparatus and in

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that the content of the file of said non-volatile data carrier is accepted into a memory which is provided in the apparatus, because by providing the external memory allows update by downloading to the nonvolatile memory in the apparatus, with other content files which identifies the recording medium and enable reading the recording medium by the information content downloaded to the memory of the apparatus, as suggested by Scibora..

9. Claim 5,6,11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bakx U.S. Patent No. 5,072,435 in view of Shim U.S. Patent No. 6,608,804.

Bakx discloses all the limitations based on claims 1, 3, 7 and 9 as outlined above. But Bakx does not expressly disclose reading a Burst Cutting Area "BCA" data area of the optical recording medium is read as the identification information

However, the features of a "BCA" data area used to obtain identification information or other types of information, is well known in the art and as evidenced by Shim.

Shim discloses a method for quickly producing read or write readiness of an apparatus for reading from or writing to an optical recording medium, the recording medium having identification information items which individually identify the recording medium individually among recording media of the same type (i.e. same types: "Optical Media", among the same type DVD, CD, CD-ROM, DVD-ROM etc.), which includes an identification information item of a Burst Cutting Area "BCA" to rapidly and accurately performs discrimination of the different discs.

It would have been obvious to one with ordinary skill in the art to include the identification information as in "BCA" identification in order to quickly and accurately performing the identification as suggested by Shim, and further since the BCA signal level is larger in amplitude and longer in cycle as compared with the pit signal of the program area of the recording medium, the BCA signal is easily distinguished at the time of reproducing by a simple circuit, furthermore the BCA would also aids in piracy protection as well know in the art.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. U.S. Patent No. 4,989,195 to Suzuki, which discloses a recording/reproducing system and method for use with a plurality of different types of disks, each of the disks having an identification signal recorded thereon which uniquely identifies the different types of disks. The system also includes a memory for storing a plurality of operating conditions/parameters for the disk drive. The plurality of operating conditions/parameters are arranged in the memory such that each of the different types of disks has a corresponding set of operating conditions. The control circuit reads from the memory that set of operating conditions corresponding to the identified type of disk, and controls the disk drive according to the read set of operating conditions.


Response to Arguments

11. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


DAVID L. OMETZ
PRIMARY EXAMINER